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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/556,038	11/09/95	BOUSSIOTIS	RPI 0120

LAHIVE & COCKFIELD, LLP  
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BOSTON MA 02109

HM12/0616

EXAMINER
GAMDEL, F

ART UNIT	PAPER NUMBER
1044	

DATE MAILED:

06/16/99 17

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

08/556038

Applicant(s)

BOUSSON & ET AL

Examiner

GAMMEL

Group Art Unit

1644

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Response

A SHORTENED STATUTORY PERIOD FOR RESPONSE IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a response be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for response specified above is less than thirty (30) days, a response within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for response is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to respond within the set or extended period for response will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 4/12/99
- ☒ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 48, 72-75, 77-91, 93-98, 102 is/are pending in the application.
- Of the above claim(s) 48, 72-75, 77-91, 93-98 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 102 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
  - ☐ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
  - ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_
  - ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☐ Interview Summary, PTO-413
- ☐ Notice of References Cited, PTO-892
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Other \_\_\_\_\_

Office Action Summary

### DETAILED ACTION

1. The location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 1644, Technology Center 1600.

2. Applicant's amendment, filed 4/12/99 (Paper No. 16), is acknowledged.  
Claims 49-71, 76, 92, 99-101 have been canceled. Claims 1-47 have been canceled previously.  
Claims 48, 72, 77, 82, 83, 89, 97 and 98 have been amended.  
Claim 102 has been added.

Claims 48, 72-75, 77-91, 93-98 and 102 are pending.

Applicant's request filed 4/12/99 (Paper No. 16), to extend the search to remaining species of previously elected Group II is acknowledged. Applicant's understanding that it is proper within a species election to request consideration of additional species if applicant is willing to delete the previously elected species from the claims is acknowledged.

However, newly submitted claims and species are directed to species that have been considered distinct from the elected species because their structures and modes of action are different which, in turn, address different conditions and endpoints, as set forth in the Restriction/Election Requirement (Paper No. 7). Since applicant has received an action on the merits for the originally presented invention and species, this invention has been constructively elected by original presentation for prosecution on the merits.

Claim 102 is under consideration as the elected invention, drawn to inhibiting T cells with  $\gamma$  chain-specific antibodies.

Accordingly, claims 48, 72-75, 77-91, 93-98 are withdrawn from consideration as being directed to a non-elected invention. See 37 C.F.R. § 1.142(b) and M.P.E.P. § 821.03.

It is noted that amended claim 98 recites "inhibiting response in an anergic T cell". Given that anergic T cells are considered unresponsive, inhibiting said anergic T cells would be considered as stimulating responses in said T cells. This does not read on the elected invention, which is drawn to inhibiting T cells in an immunosuppressive manner.

3. The text of those sections of Title 35 USC not included in this Action can be found in a prior Action. This Office Action will be in response to applicant's arguments, filed 4/12/99 (Paper No. 16). The rejections of record can be found in the previous Office Action (Paper No. 11).

4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Applicant should restrict the title to the claimed invention.

5. This application has been filed with informal drawings which are acceptable for examination purposes only.
6. The application is required to be reviewed and all spelling, TRADEMARKS, and like errors corrected.

Trademarks should be capitalized or accompanied by the™ or ® symbol wherever they appear and be accompanied by the generic terminology. Although the use of trademarks is permissible in patent applications, the proprietary nature of the trademarks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

7. Upon reconsideration of the recitation of claim 102, as the elected invention and the prior art of record as evidenced by Shimamura et al. (U.S. Patent No. 5,582,826) and Sugamura et al. (U.S. Patent No. 5,705,608); the previous rejection under 35 U.S.C. § 112, first paragraph, has been withdrawn.

8. Claim 102 is are rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Shimamura et al. (U.S. Patent No. 5,582,826) (see entire document) for the reasons of record set forth in Paper No. 11

Applicant's arguments, filed 4/12/99 (Paper No. 16), have been fully considered but are not found convincing. Applicant arguments focus on the mechanism of action by arguing that Shimamura et al. fails to teach the limitation of "a signal associated with ligation of the cytokine receptor  $\gamma$  chain".

As pointed out previously, Shimamura et al. teach the use of cytokine receptor  $\gamma$  chain-specific antibodies as an immunosuppressant medicine effective in preventing the rejection of grafts after transplantation and also in treating inflammatory diseases such as allergic disease and autoimmune diseases (see Summary of the Invention and column 3, paragraph 1). Applicant is reminded that no more of the reference is required than that it sets forth the substance of the invention. The claimed functional limitations addressed by the applicant would be inherent properties of the referenced cytokine receptor  $\gamma$  chain-specific antibodies to treat the same inflammatory conditions encompassed by the claimed methods. Although the reference is silent about the mechanism of action of cytokine receptor  $\gamma$  chain-specific antibodies, the reference clearly teaches the use of the same cytokine receptor  $\gamma$  chain-specific antibodies to inhibit the same T cell responses including conditions encompassed by the same therapeutic modalities as applicant. . Also see Ex parte Novitski 26 USPQ 1389 (BPAI 1993).

The referenced methods of inhibiting T cells responses via the use of cytokine receptor  $\gamma$  chain-specific antibodies would have the inherent property of inhibiting associated signals, absent objective evidence to the contrary. Applicant's arguments are not persuasive.

9. Claim 12 is rejected under 35 U.S.C. § 102(b) as anticipated by or, in the alternative, under 35 U.S.C. § 103 as obvious over Sugamura et al. (U.S. Patent No. 5,705,608) (see entire document) for the reasons of record set forth in Paper No. 11.

Given the absence of applicant's arguments, filed 4/12/99 (Paper No. 16) in response to this rejection of record; it appears that applicant has acquiesce to the rejection of record. The rejection is maintained for the reasons of record

Alternatively, if applicant arguments were to focus on the mechanism of action by arguing that Sugamura et al. fails to teach the limitation of "a signal associated with ligation of the cytokine receptor  $\gamma$  chain"; the rejection would be maintained for the reasons of record and those address above for Shimamura et al. (U.S. Patent No. 5,582,826).

10. No claim is allowed.

11. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phillip Gambel whose telephone number is (703) 308-3997. The examiner can normally be reached Monday through Thursday from 7:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on (703) 308-3973. Any inquiry of a general nature or relating to the status of this application should be directed to the Technology Center 1600 receptionist whose telephone number is (703) 308-0196.

Papers related to this application may be submitted to Technology Center 1600 by facsimile transmission. Papers should be faxed to Technology Center 1600 via the PTO Fax Center located in Crystal Mall 1. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). The CM1 Fax Center telephone number is (703) 305-3014.

Phillip Gambel, PhD.  
Patent Examiner  
Group 1640  
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June 10, 1999

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